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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ming Lau

Serial No. 75/619,998

Lawrence A. Maxham of Baker & Maxham for Ming Lau.

Won T. Oh, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Hairston, Rogers and Drost, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Ming Lau has filed an application to register the mark GW GREAT WALL EXPRESS as shown below,

for "restaurant services."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with restaurant services, so resembles each of the following marks, which are registered to the same entity, as to be likely to cause confusion, mistake or deception:

GREATWALL for "canned goods-namely, meat, fish poultry, fruits, vegetables and jams";[2]

GREATWALL BRAND and design as shown below,

for "canned goods-namely, meat, fish, poultry, fruits, vegetables and jams";[3] and

[1] Serial No. 75/619,998, filed January 12, 1999, alleging dates of first use of March 18, 1994.
[2] Registration No. 1,100,901 issued August 29, 1978; renewed.
[3] Registration No. 1,100,902 issued August 29, 1978; renewed. The Chinese characters are translated into English as "Great Wall Brand."

GREATWALL and design as shown below,

for "beer".[4]

In addition, the Trademark Examining Attorney has made final a requirement that applicant disclaim EXPRESS apart from the mark as shown.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

We turn first to the requirement for a disclaimer of the word EXPRESS. It is the Examining Attorney's position that the word EXPRESS describes a feature or characteristic

[4] Registration No. 1,249,970 issued June 7, 1983; Section 8 affidavit filed. As in the previous registration, the Chinese characters are translated into English as "Great Wall Brand."

of applicant's restaurant services, namely that food is provided to customers quickly. While the Examining Attorney acknowledges that applicant's services are not specifically identified as fast-food or "express" restaurant services, the Examining Attorney maintains that applicant's recitation of services is broad enough to encompass fast-food or "express" restaurant services. In support of the disclaimer requirement, the Examining Attorney submitted copies of twenty-four third-party registrations for marks which include EXPRESS for restaurant services wherein such word is disclaimed.

Applicant, on the other hand, contends that according to definitions taken from Webster's Ninth New Collegiate Dictionary, the word "express" means exigency, something explicit or a mode of transportation, and thus, "[express] is not inexorably relevant to restaurant services." (Brief, p. 3).

In this case, we agree with the Examining Attorney that EXPRESS is descriptive of a feature or characteristic of applicant's services and must be disclaimed. We judicially notice The American Heritage Dictionary of the English Language (4th ed. 2000) wherein the word "express" is defined as, inter alia, "sent out with or moving at high

speed."[5] When we consider this definition of "express" in connection with applicant's services, it is readily apparent that "express" describes the fact that the food is sent out or provided to customers quickly. That the Office has considered this term descriptive of a feature or characteristic of restaurant services is borne out by the third-party registrations wherein the term is disclaimed. Moreover, as pointed out by the Examining Attorney, because applicant's services are broadly identified as restaurant services, they are broad enough to encompass restaurant services which are fast-food or "express" in nature. In view of the foregoing, the requirement for a disclaimer of EXPRESS is appropriate.

We turn next to the refusal to register under Section 2(d) of the Trademark Act. Our determination under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the

[5] The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

marks and the similarities between the goods and/or services.

We note at the outset, that there is no *per se* rule which requires a finding that confusion is likely whenever food items and restaurant services are offered under similar marks. See, e.g., Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641 (CCPA 1982) [no likelihood of confusion between BOSTON TEA PARTY for tea and BOSTON SEA PARTY for restaurant services; "a party must show something more than that similar or even identical marks are used for food products and for restaurant services"]; and In re Central Soya Company, Inc., 220 USPQ 914 (TTAB 1984) [no likelihood of confusion between POSADA (stylized) for Mexican style prepared frozen enchiladas and LA POSADA for lodging and restaurant services].

We should point out that although the Examining Attorney listed in the introductory section of his brief Registration No. 1,249,970 for the mark GREATWALL and design for beer as a basis for refusing registration under Section 2(d), there is no discussion or argument with respect to this registration in his brief. Inasmuch as it appears that the Examining Attorney is not pressing the refusal on the basis of this registration, we deem such

refusal to have been withdrawn and we have given it no consideration. For purposes of our decision then, we have considered only Registrations Nos. 1,100,901 and 1,100,902 for the marks GREATWALL and GREATWALL BRAND and design, respectively.

We compare first applicant's mark GW GREAT WALL EXPRESS and the marks GREATWALL and GREATWALL BRAND and design. Although there are similarities between applicant's mark and registrant's marks due to the shared presence of the term GREAT WALL, we find that there are specific differences between applicant's mark and these two cited marks. In particular, the inclusion in applicant's mark of the joined letters "G" and "W" displayed in a prominent manner results in a mark that, when considered in its entirety, is different in appearance from GREATWALL and GREATWALL BRAND and design.

More importantly, as to the respective goods and services, we are not persuaded, on this record, that restaurant services, on the one hand, and canned meat, fish, poultry, fruits, vegetables and jams, on the other hand, are related. In support of his contention that such goods and services are related, the Examining Attorney submitted thirteen registrations which cover restaurant services on the one hand, and various food items, on the

other hand. However, there are several problems with the registrations. None of the thirteen registrations covers canned food items of any kind. Rather, they cover prepared foods or fresh and/or frozen food items. Moreover, seven of the registrations issued under Section 44(e) of the Trademark Act, rather than on the basis of use in commerce, and two of the registrations are clearly house marks and cover a variety of food items and other unrelated products and services. In short, these registrations do not satisfy the "something more" evidence requirement set forth by the Court in Jacobs v. International Multifoods Corp., supra, at 212 USPQ 643. While the Examining Attorney has relied on In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999), in support of his contention that restaurant services and the canned foods identified in the cited registrations are related, we believe that case is distinguishable from the facts herein. In that case, the Board found a likelihood of confusion between the applicant's restaurant services rendered under the mark AZTECA MEXICAN RESTAURANT and the registrant's Mexican food products sold under the mark AZTECA. Not only were the marks in In re Azteca substantially similar, but the record therein consisted of ten use-based third-party registrations of marks which were registered for restaurant

services, on the one hand, and food items, on the other hand. In addition, five of the registrations covered both restaurant services and Mexican food items.

In sum, when we consider the specific differences in applicant's mark and the cited marks along with the fact that the record lacks the "something more" necessary to establish that restaurant services and canned foods are related, it is our view that applicant's use of the mark GW GREAT WALL EXPRESS is not likely to cause confusion with the marks GREATWALL and GREATWALL BRAND and design.

Decision: The refusal to register under Section 2(d) of the Act in view of Registration Nos. 1,100,901 and 1,100,902 is reversed.

The requirement for a disclaimer of the word EXPRESS is affirmed. Nonetheless, this decision will be set aside and applicant's mark published for opposition if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of EXPRESS.